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No. 99-1571

In The

Supreme Court of the United States

TRAFFIX DEVICES, INC.,

Petitioner,

v.

MARKETING DISPLAYS, INC.,

Respondent.

On Writ Of Certiorari To The United States Court Of Appeals For The Sixth Circuit

AMICUS CURIAE BRIEF OF THE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF RESPONDENT

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AMICUS CURIAE BRIEF OF THE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF RESPONDENT

The American Intellectual Property Law Association ("AIPLA") respectfully submits this brief as amicus curiae in support of the Respondent.[1]

INTEREST OF THE AMICUS CURIAE

The American Intellectual Property Law Association ("AIPLA") is a national bar association of more than 10,000 members with interests and practices primarily in the areas of trademark, patent, copyright, trade secret and other intellectual property law. Unlike areas of practice in which separate and distinct plaintiffs' and defendants' bars exist, most intellectual property law attorneys represent both intellectual property owners and alleged infringers.

The AIPLA has no stake in the parties to this litigation or in the outcome in this case, other than its interest in seeking correct and consistent interpretation of the law relating to intellectual property.

SUMMARY OF THE ARGUMENT

The Court of Appeals for the Sixth Circuit decided this case in accordance with the decisions of this Court

[1] Both parties have consented to the submission of this brief through letters filed with the Clerk of the Court. Counsel for AIPLA authored this brief in its entirety. No other person or entity has made any monetary contribution to the preparation or submission of this brief.

and of the Federal, Fifth, Seventh and Ninth Circuits. The Court should not impose a *per se* rule that an expired utility patent covering a manufacturer's product prevents that manufacturer from ever enforcing trade dress rights in that product's configuration. The Patent Act and the Lanham Act protect different interests. The patent laws' objective is to encourage inventors to innovate and to disclose their inventions to the public, by giving patent holders exclusive rights to make, use and sell the disclosed inventions for a limited term of years. The Lanham Act protects manufacturers and consumers from confusing or misleading designations of the origin of goods or services. These two federal statutory schemes do not conflict. A patent's expiration gives competitors the right to use the invention of the patent, to the extent that it removes the threat of a suit for infringement of that patent. It does not give competitors an absolute right to copy the trade dress of the patentee's product – as Petitioner asserts – if such copying is likely to confuse consumers as to the source of the competing product. For its part, the Lanham Act, which encourages competition by preventing one competitor from misappropriating the goodwill and reputation of another, only prohibits copying nonfunctional product features that serve as identifiers of source. Product configurations that are primarily functional are not protectable as trade dress. By applying this doctrine of functionality, the courts have enforced the Lanham Act and unfair competition laws so as to avoid offending the objectives of the patent laws, which protect functional inventions. Additionally, the requirement of secondary meaning for trade dress protection of product

configurations means that courts will only protect product designs that are shown to act as source-identifiers. Application of these two threshold tests ensures that a plaintiff which previously obtained a utility patent for the invention embodied in its product is only protecting its trade dress rather than its patented invention.

The *per se* rule advocated by Petitioner would be overbroad. It would unfairly deprive manufacturers of the right to protect trade dress rights in nonfunctional source-identifying design elements that a competitor does not need to practice the invention formerly covered by a patent. A *per se* rule would frustrate the purposes of the Lanham Act in those situations where a competitor, in addition to exercising its right to use the invention claimed in an expired patent, copies the nonfunctional and source-identifying features of the plaintiff's product, in a manner likely to confuse or mislead consumers. Rather than competitors merely gaining the rights they would have had if the expired patent had never existed, they would get an extra right – to copy their competitor's specific nonfunctional trade dress regardless of likelihood of confusion. At the end of a patent term, the patentee would not only lose the right to exclude others from practicing its invention, as contemplated by the patent "bargain," but it would lose the goodwill embodied in its nonfunctional trade dress as well. That result would hardly promote the objectives of the patent laws and would frustrate the objectives of trademark and unfair competition law. For these reasons, the Court should reject the invitation to adopt the *per se* rule urged by the Petitioner.

ARGUMENT

I. THAT A PRODUCT EMPLOYS AN INVENTION CLAIMED IN A UTILITY PATENT DOES NOT, IN ITSELF, PREVENT THE PRODUCT'S CONFIGURATION FROM BEING PROTECTED AS TRADE DRESS

A. The Expiration Of A Patent Does Not Create An Absolute "Right To Copy" A Product If Such Copying Violates Another's Rights Under Other Statutes Or Common Law.

The Petitioner argues that when a utility patent expires, the public acquires not only the right to practice the patented invention but the right to copy any product that was sold under that patent during its term, including its nonfunctional configuration.[2] Petitioner urges that allowing the owner of an expired utility patent to assert trade dress rights in its product configuration deprives the public of the benefit of the patent bargain and thus frustrates the purposes of the patent laws. *See* Petitioner's brief at 2-3, 15-16. This argument is unsupported by the Court's decisions and has been soundly rejected by the Federal Circuit, the Court of Appeals charged with creating national uniformity in administration of the patent laws. *See Midwest Indus. Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 1362-64 (Fed. Cir.), *cert. denied*, 120 S. Ct. 527 (1999) (reversing district court's holding that plaintiff's trailer hitch winch post could not be protected as trade

[2] This case involves only a "utility" patent. The effect of a design patent on trade dress rights in a product configuration is not before the Court in this case and this brief expresses no opinion on that issue.

dress because it was the "significant inventive aspect" of a utility patent). The Federal Circuit followed an opinion of its predecessor, the Court of Customs and Patent Appeals, and explained that

> [t]rademark rights, or rights under the law of unfair competition, "do not 'extend' the patent monopoly." Rather, they exist independently of it, under different law and for different reasons. The termination of either has no legal effect on the continuance of the other. When the patent monopoly ends, it ends. The trademark rights do not extend it. We know of no provision of patent law, statutory or otherwise, that guarantees to anyone an absolute right to copy the subject matter of any expired patent. Patent expiration is nothing more than the cessation of the patentee's right to exclude held under the patent law.

Id. at 1362 (quoting *In re Mogen David Wine Corp.*, 328 F.2d 925, 930 (C.C.P.A. 1964)). Thus, the Federal Circuit concluded that if a product configuration meets the requirements for protectable trade dress under the Lanham Act or common law unfair competition, the existence of a patent does not, by itself, preclude enforcing trade dress rights. The only significance of a patent "covering" the device is that it may provide evidence that an asserted trade dress is functional, and thus not protectable as trade dress. *Id.*[3] The court quoted its earlier caveat

[3] The Seventh, Fifth and Ninth Circuits have reached the same conclusion based on similar rationales. *See Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 288 (7th Cir. 1998) (concluding that disclosure of a product configuration in an expired patent was "some evidence" of functionality but not

that in resolving functionality issues, "reference to patent utility claims that are, or have been, asserted to read on either product, or to the appearance of the device depicted in figures included in the patent specification supporting such claims, must be done with caution." *Id.* (quoting *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1031 (Fed. Cir. 1985)).

The Petitioner argues that the Sixth Circuit's decision below conflicts with this Court's opinions in *Bonito Boats Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938),[4] *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964) and *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896), because it interferes with the public's "right" to copy the patentee's product after a patent expires. *See, e.g.*, Petitioner's brief at 17-24. Petitioner's reliance on these cases is misplaced. First, *Bonito Boats* did not involve a product covered by

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determinative and reversing summary judgment that plaintiff's trade dress was not protectable); *Sunbeam Prods. v. West Bend Co.*, 123 F.3d 246, 256 (5th Cir. 1997) (that plaintiff's mixer configuration "incorporates functional features named in utility patents does not compel the conclusion that the product configuration is legally functional"); *Clamp Mfg. Co. v. Enco Mfg. Co.*, 870 F.2d 512, 516 (9th Cir. 1989) (affirming injunction and damages for a trade dress plaintiff, finding that the trade dress was not primarily functional despite the existence of an expired utility patent); *see also Clamp Mfg. Co. v. Enco Mfg. Co.*, 227 USPQ 335, 336 (C.D. Cal. 1985) ("the existence of a utility patent is just one factor when deciding whether a product configuration is functional. . . . The existence of a patent, either in force or expired, does not foreclose the acquisition of trademark rights in matters disclosed in the patent.").

[4] The *Singer* and *Kellogg* cases predate the Lanham Act.

an expired utility patent.[5] In *Bonito Boats* the Court was primarily concerned with whether a Florida statute prohibiting the copying of boat hulls by direct hull molding was preempted by the federal patent laws, without regard to whether the requirements for protecting trade dress were met (*i.e.*, proving likelihood of confusion of a distinctive and nonfunctional design). *See* 489 U.S. at 144. The issue here is a potential conflict between two federal statutes, the Patent Act and the Lanham Act, not preemption. *See Zenith Elecs. Corp. v. Exzec, Inc.*, 182 F.3d 1340, 1347 (Fed. Cir. 1999). Second, in *Bonito Boats*, the Court explained that reading its precedent "to prohibit the States from regulating the deceptive simulation of trade dress" would be "inappropriate." 489 U.S. at 154. Indeed, the Court took pains to clarify that "our decision in *Sears* clearly indicates that the States may place limited regulations on the circumstances in which such designs are used *in order to prevent consumer confusion as to source.*" *Id.* (emphasis added).

In finding the Florida boat hull statute to be incompatible with patent law objectives because it offered "patent-like" protection to unpatented designs, the Court expressly distinguished such statutes from unfair competition statutes and common law, which offer different protection for different reasons. The Court further explained:

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[5] The plaintiff in *Bonito Boats* proceeded only under the Florida statute prohibiting direct hull molding. The Court noted that there was "no indication in the record that a patent application was ever filed for protection of the utilitarian or design aspects of the hull, or for the process by which the hull is manufactured." 489 U.S. at 144.

> [T]he common law tort of unfair competition has been limited to protection against copying of nonfunctional aspects of consumer products which have acquired secondary meaning such that they operate as a designation of source. (citation omitted). The "protection" granted a *particular* design under the law of unfair competition is thus limited to one context where consumer confusion is likely to result; the design "idea" itself may be freely exploited in all other contexts.

489 U.S. at 158 (emphasis added).[6] Although this passage concerns common law unfair competition law rather than the Lanham Act, the Court explained later that in passing the Lanham Act, Congress gave "federal recognition to many of the concerns that underlie the state tort of unfair competition." *Id.* at 166. Thus, this Court has made it clear that the Lanham Act and the Patent Act can coexist, due to the functionality doctrine. A *per se* rule against allowing trade dress protection of any design of a product previously covered by a patent is not necessary to avoid offending fundamental objectives of patent law.

[6] As discussed below, the tests for functionality and for secondary meaning in Lanham Act jurisprudence are well-established and essentially consistent throughout the Courts of Appeals.

B. Protecting A Patentee's Product Configuration As Trade Dress Does Not Conflict With Patent Law Because A Patent Claims And Discloses An Invention, Not The Patentee's Product.

As highlighted in the Petition for Certiorari, the Tenth Circuit has parted company with the other circuits and held that "patent law seeks the invention and passing into the public domain of *even what trade dress law would consider nonfunctional* . . . features of patented products" and that trade dress protection of such features after a patent expires thus "impinges seriously upon the patent system's core goals." *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1508 (10th Cir. 1995). As explained above, this Court's decisions do not support that conclusion and, on the contrary, expressly hold that protecting nonfunctional features of covered products as trade dress does not offend patent objectives by extending patent-like protection indefinitely. *See Bonito Boats*, 489 U.S. at 158.[7]

To be sure, the patent "bargain" is that an inventor, in exchange for an enforceable right to exclude others from practicing his invention for a term of years, discloses the invention to the public and places the invention in the public domain at the end of that term. *See id.* at 150; *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480 (1974);

[7] While *Vornado's* holding is based on the same erroneous premise as Petitioner's argument, even the Tenth Circuit does not apply the *per se* rule Petitioner advocates. The Tenth Circuit attempted to ensure that only "the subject matter of the patent" passes to the public domain by only barring trade dress protection of configurations that are both "part of a claim" and a "described significant inventive aspect." *Id.* at 1510.

Aronson v. Quick Point Pencil Co., 440 U.S. 257, 262 (1979). The public, however, obtains some, perhaps most, of the benefit of its "bargain" when the patent issues and is published and its disclosure becomes available to the public, because the public immediately is able to learn from the patent *how* to practice the invention, even if it has no right to do so during the term of the patent without the patentee's permission. *See Griffith v. Kanamaru*, 816 F.2d 624, 626 (Fed. Cir. 1987) (explaining that early public disclosure of an invention in a patent is the "linchpin" of the patent system). This published disclosure immediately serves to stimulate further innovation long before the public has the right to practice the invention. Indeed, the Court can appreciate that with the increasing speed of technological progress, a patented invention may be obsolete well before the patent expires.

What the public gains at the expiration of a patent is a direct function of what right the patent guaranteed during its term. It is a fundamental principle of patent law that what a patent imparts is the right to exclude others from practicing an invention. *See* 35 U.S.C. § 154. Thus, a patent only indirectly protects the patentee's own *product* from copying.[8] A patent does not even guarantee

[8] A patentee does not give up all other forms of protection other than the patent for features of his own commercial product. *See Kohler Co. v. Moen, Inc.*, 12 F.3d 632, 638 (7th Cir. 1993) ("[C]ourts have consistently held that a product's different qualities can be protected simultaneously, or successively, by more than one statutory means for the protection of intellectual property.") For example, one may obtain a patent that covers methods of manipulating data using a computer and also register a copyright on its own software

its *inventor or owner* the right to make, use or sell products embodying the invention, if such acts would infringe another's patent or other rights. Accordingly, *Bonito Boats* and other cases speak of "the subject matter of the patent" – rather than the patentee's commercial product – passing into the public domain upon the patent's expiration. *Bonito Boats*, 489 U.S. at 152.

As a result of its incorrect reading of this Court's precedent, the Tenth Circuit created a new test to be applied when a defendant raises an expired patent as a defense to trade dress infringement. In contrast to the well-developed functionality test discussed below, the test applied in *Vornado* requires courts to construe patent claims to decide whether an element is a "significant inventive aspect" (a phrase that has little, if any, established meaning). 58 F.3d at 1510 ("we do not wish to rule out the possibility that a court may appropriately conduct a factual inquiry to supplement its reading of the patent's claims and descriptions.") Thus, even the Tenth Circuit did not adopt the *per se* rule Petitioner proposes. Essentially, the *Vornado* court has prescribed a *Markman*-like[9]

that implements the patented method. *See Atari Games Corp. v. Nintendo of America Inc.*, 975 F.2d 832, 839 (Fed. Cir. 1992). A manufacturer can also assert trade secret rights associated with a product that also practices inventions on which it holds a patent. *See, e.g., Roton Barrier, Inc. v. Stanley Works*, 79 F.3d 1112, 1119 (Fed. Cir. 1996) (enforcing patents and trade secrets pertaining to plaintiff's hinges).

[9] In *Markman v. Westview Instruments, Inc.*, the Federal Circuit held that patent claim construction or interpretation is an issue of law to be determined by the court. 52 F.3d 967, 990 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996). In patent infringement suits, the district court typically holds a separate

hearing when a utility patent is cited as grounds for finding a product configuration unprotectable as trade dress. Adoption of the *Vornado* test also would require the regional circuits to review district courts' patent claim constructions, undercutting the Federal Circuit's ability to maintain uniformity in application of the patent law. *See Thomas & Betts*, 138 F.3d at 289-90 (reviewing and reversing district court's claim construction). There is no need for courts to undertake this exercise. This Court made it clear in *Bonito Boats* that the existing requirement that protectable trade dress be nonfunctional prevents the application of the Lanham Act from offending patent law objectives.

A patent's scope is determined by its claims, not by the patentee's own product and not by an embodiment described in the patent specification. *See SRI Intl. v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc) (patent infringement "is determined by comparing an accused product not with a preferred embodiment described in the specification, or with a commercialized embodiment of the patentee, but with the properly and previously construed claims in suit."); *see also Environmental Instruments, Inc. v. Sutron Corp.*, 877 F.2d 1561, 1564 (Fed. Cir. 1989) ("The claims alone delimit the right to exclude; only they may be infringed.") A patent does not prohibit use of a specific element, no matter how "inventive," except in combination with other elements as set

Markman hearing on the issue of how the claims of the patent(s) in suit are to be construed.

forth in the claims. *See, e.g., Wolverine World Wide, Inc. v. Nike, Inc.*, 38 F.3d 1192, 1199 (Fed. Cir. 1994).[10]

Similarly, a patentee can hardly be said to be "extending" the patent monopoly through trade dress protection, because the Lanham Act only allows him to prevent others from selling products that create a likelihood of confusion with his own nonfunctional, distinctive trade dress, and leaves him powerless to prevent competitors from using the invention if they do not also simulate his trade dress. *See Sunbeam Prods.*, 123 F.3d at 256 ("granting trade dress protection to the arbitrary product configuration of the American Classic MixMaster(R) would not restrict any competitors from copying the individual functional features after the individual utility patents have expired, but would simply prohibit competitors from copying the arbitrary combination of features embraced in the American Classic MixMaster(R)"). Because trade dress protection of nonfunctional product designs does not extend the patent grant, there is no conflict with patent law or the Constitution.

[10] A patentee cannot enforce his patent against one who merely uses one "significant inventive aspect" of the invention. Thus there is a lack of nexus between the Tenth Circuit's test – forbidding trade dress protection for a design if it is a "significant inventive aspect" – and the objective it purported to serve – preventing "extension" of the patent grant.

II. THE WELL-SETTLED CRITERIA FOR TRADE DRESS PROTECTION OF PRODUCT DESIGNS ARE SUFFICIENT TO AVOID FRUSTRATING THE PURPOSES OF THE PATENT ACT

A. One Seeking To Enforce Rights In Unregistered Trade Dress Must Prove Its Design Is Nonfunctional, Which Will Be Impossible If The Configuration Is Essential To Practice An Invention Having Utility.

The Lanham Act serves two distinct purposes: protecting providers of goods and services from unfair competition and protecting consumers from misleading marketing practices. *See, e.g., Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992); *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 164-65 (1995)). The determinative test of trade dress infringement is whether the defendant's use of its trade dress creates a likelihood of confusion as to the source or sponsorship of the goods or services. *See* 15 U.S.C. § 1125(a)(1)(A). The Lanham Act is intended to encourage competition by preventing one competitor from misappropriating another's goodwill by passing off its goods as another's. *See Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985).

The Act is not intended to inhibit competition by allowing one producer to control a useful product feature. To avoid that result, it requires that a party alleging trade dress infringement show that its trade dress is nonfunctional.

> In a civil action for trade dress infringement under this Act for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving

> that the matter sought to be protected is not functional.

15 U.S.C. § 1125(a)(3) (1999).

"The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature." *Qualitex*, 514 U.S. at 164. A product feature is functional and cannot be protected as trade dress "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982). A product configuration is legally functional if allowing one competitor to protect it as trade dress would hinder other manufacturers' ability to compete. *See Qualitex* at 514 U.S. at 169-70.

The functionality doctrine prevents a party from acquiring trade dress rights in functional product features even where that party can show that its trade dress has developed secondary meaning. *See id.; see also Thomas & Betts*, 138 F.3d at 288 ("configuration cannot receive trademark registration if its purpose is to contribute functional advantages to the article or quote if the configuration results from functional considerations") (quoting *Best Lock Corp. v. Schlage Lock Co.*, 413 F.2d 1195, 1199 (C.C.P.A. 1969)). The functionality test is the same, moreover, regardless of whether or not the trade dress was ever claimed or disclosed in a patent. *See Sunbeam Prods.*, 123 F.3d at 256 n.20 ("the mere fact that a feature is named in a utility patent does not automatically render it functional"). The court below properly considered

whether Marketing Displays' competitors could practice the invention of the expired patent without using Marketing Displays' specific trade dress and found that they could. *See Marketing Displays, Inc. v. TrafFix Devices, Inc.*, 200 F.3d 929, 940 (6th Cir. 1999), *cert. granted*, 120 S. Ct. 2715 (2000) ("It takes little imagination to conceive of a hidden dual-spring design or a tri or quad-spring mechanism that might also avoid infringing WindMaster's trade dress.").

The majority of the circuits to address the effect of an expired utility patent on the functionality analysis have held that the existence of such a patent is merely one factor to be considered in the functionality analysis, not a *per se* bar to enforcing trade dress rights in a product configuration.[11] This approach allows courts to consider, for example, whether the plaintiff's asserted trade dress is merely pictured in the patent as an example of one possible embodiment of the claimed invention, or whether the product configuration is described as serving a function, or as necessary to practice the invention. Courts must have flexibility to properly analyze the specific evidence bearing on whether the product configuration as a whole is primarily functional.

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[11] *See, e.g., Midwest Indus.*, 175 F.3d at 1362-64. In *Midwest*, the Federal Circuit explained that "statements in a patent may provide evidence that the asserted trade dress is functional" but held that the district court must conduct an inquiry into whether excluding use of a feature "would put competitors at a significant non-reputational-related disadvantage" (quoting *Qualitex*, 514 U.S. at 165).

The nonfunctionality requirement precludes many, perhaps even most, product configurations from qualifying for protection under the Lanham Act. *See, e.g., Disc Golf Ass'n v. Champion Discs, Inc.*, 158 F.3d 1002, 1006-08 (9th Cir. 1998) (while existence of an expired utility patent is not dispositive, where patent illustrated the claimed trade dress and described its parabolic configuration as functional and plaintiff failed to create a material issue of fact as to functionality, parabolic configuration could not be protected as trade dress.) Thus, if courts properly apply the functionality doctrine, a manufacturer cannot use trade dress litigation to preclude competitors from copying a configuration that is *necessary* in order to practice a useful invention no longer covered by a patent. If a product's configuration meets the rigorous criteria for trade dress protection of product designs, however, it should not be unenforceable merely because the manufacturer previously obtained a patent on an invention its product embodies.

B. One Seeking To Enforce Rights In A Product Design Must Prove Consumers Understand The Design To Be Source-Identifying, Rather Than A Useful Or Appealing Feature Of The Product.

The touchstone of the trade dress infringement inquiry is likelihood of confusion. This necessitates the requirement that a plaintiff's trade dress be distinctive in order to qualify for protection, because a consumer cannot be confused if he is not inferring something about the source of the product from its trade dress. *See Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, ___ U.S. ___, 120 S. Ct. 1339, 1343 (2000) ("[W]ithout distinctiveness the trade

dress would not 'cause confusion . . . . ' ") (quoting 15 U.S.C. § 1125(a)(1)(A)). In *Wal-Mart*, the Court reasoned that consumers do not necessarily infer source from a product's trade dress but instead recognize an unusual product design usually is intended "to render the product itself more useful or more appealing." *Id.* at 1344. Therefore, a party claiming infringement of unregistered trade dress has the burden of showing that its trade dress has acquired "secondary meaning," or "acquired distinctiveness" – meaning that the relevant public has come to understand the design to be identifying the product's source rather than contributing to its intrinsic value or desirability. *Id.* at 1345.

The factors considered in determining whether a given trade dress has acquired secondary meaning are essentially consistent throughout the federal courts, and familiar to practitioners in the trademark and trade dress area. Courts typically consider survey evidence, the length and manner of use of the trade dress, the nature and extent of advertising and promotion of the product, the sales volume of the product, consumer testimony, any instances of actual confusion, and any proof of intentional copying. *See* J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 15:30 (4th ed. 1996).

As noted above, the Lanham Act protects manufacturers as well as consumers from the effects of misleading designations of origin. Not only can a manufacturer lose profits if consumers mistake a competitor's product for its own, but its goodwill can be tarnished if that competitor's products are of low quality, and it even can be exposed to tort litigation if those products are defective or dangerous. *See Sindell v. Abbott Labs*, 607 P.2d 924,

937-38 (Cal. 1980) (holding that plaintiff could recover against manufacturers according to their market share where plaintiff could not identify the manufacturer of the drug that injured her, but joined 90% of the manufacturers of that drug). For products not easily packaged or labeled, a product configuration trade dress may be the only way to identify the source of the goods.

A patentee manufacturer exercises a significant degree of control, during the term of the patent, over whether consumers come to view an aspect of the product's design as source-identifying. To develop secondary meaning, a manufacturer usually must do something to overcome the natural predisposition of consumers to view product designs solely as useful or appealing qualities of the product rather than as indicia of source. That may mean advertising the product so as to make clear that some aspect of the product design can be used to identify its source. *See In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1128 (Fed. Cir. 1985) (holding that manufacturer could register and protect the color pink as a trademark for fiberglas insulation).[12] In contrast, if a patentee touts its configuration's functionality during the

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[12] In *Owens-Corning*, the Federal Circuit found that Owens-Corning had established secondary meaning through, among other things, evidence of its extensive advertising expressly referring to the pink color of its insulation, including its advertising campaign using the Pink Panther cartoon character and slogans like "Put your house in the pink!" and "think pink!" – in other words, advertising that directly told consumers that they could use the pink color of Owens-Corning insulation to identify it as Owens-Corning's, rather than pink being a natural quality of fiberglas or adding some functional or aesthetic quality to the insulation.

term of the patent, that advertising is a factor that weighs in favor of finding that the product design is functional. *See, e.g., Disc Golf*, 158 F.3d at 1009 (finding that plaintiff's advertising implied its product design was functional).[13] Applying a *per se* rule, however, would treat the plaintiff that has taken steps to develop secondary meaning in a product design the same way it treats one that previously has told consumers that its configuration imparted some superior functional quality to its product.

Petitioner expresses concern that suits alleging trade dress infringement are too readily brought as meritless "strike suits" that are expensive to defend. This concern applies to all such suits, of course, and not merely to those involving an expired utility patent. The *Wal-Mart* opinion specifically considered such suits in deciding that a plaintiff must show secondary meaning to protect a product design. *See Wal-Mart*, 120 S. Ct. at 1345. A predictable result of *Wal-Mart* is that trade dress owners

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[13] *Vornado* was decided well before *Wal-Mart* and the district court found that the plaintiff's AirTensity grill configuration was inherently distinctive. *See* 58 F.3d at 1502. Thus, the district court never considered whether Vornado had established secondary meaning. The *Vornado* court could have reached the same result, finding the grill not protectable, by holding that the evidence of Vornado's claims to the U.S. Patent and Trademark Office and its advertising claims showed that the plaintiff could not show secondary meaning in its trade dress, and that consumers believed the AirTensity grill configuration to be a feature that improved a fan's performance, rather than an indicator that Vornado made the fan. For example, the plaintiff had advertised that its spiral-shaped fan grill was "a true achievement in aerodynamic efficiency," "the result of determinant ergonomic design" and had "unique AirTensity vortex action." *Vornado*, 58 F.3d at 1500.

evaluating potential litigation, including those who formerly held utility patents, will be encouraged to collect evidence to show their product configuration has acquired secondary meaning, and not to sue if they encounter difficulty in doing so. Like the nonfunctionality requirement, the requirement of secondary meaning ensures that the application of the Lanham Act will prevent consumer confusion and unfair competition rather than undermining patent law objectives. There is no need for the overbroad *per se* rule that petitioner advocates.

III. CONCLUSION

For the foregoing reasons, the Court should reject the *per se* rule proffered by Petitioner and affirm the judgment of the Court of Appeals.

Respectfully submitted,

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